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**OFFICE OF PETITIONS**

In re Application of :  
Daniel M. Marks et al :  
Application No. 10/666,560 : **DECISION DISMISSING PETITIONS**  
Filed: September 22, 2003 : **UNDER 37 CFR 1.78(a)(3) AND (a)(6)**  
Attorney Docket No. 110293.134 US1 :

This is a decision on the petition treated under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed January 31, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed nonprovisional and provisional applications noted in the petition.

The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(iii) and 1.78(a)(5)(i) and 1.78(a)(5)(iii) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with items (1) and (3).

It appears that petitioner is seeking to claim priority to nonprovisional Application No. 10/438,325 and provisional Application No. 60/380,325, which applications were not previously claimed. However, the claim for benefit of priority as drafted is unacceptable and, therefore, is not considered a proper reference. In this regard, the claim for benefit of priority is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the

claim for priority) must commence on a separate physical sheet. The rule at 37 CFR 1.4(c) states that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office. It also appears that a previous claim for priority was made to provisional Application No. 60/412,012. Therefore, if petitioner still desires to claim priority to this prior-filed provisional application, the amendment should also include this application. The claim for priority may also be made in a signed Supplemental Application Data Sheet. *See* 37 CFR 1.76(b) and 37 CFR 1.33(b).

As to item (3) above, the statement of unintentional delay is unacceptable for two reasons. In this regard, the statement reads: "Applicants state that the entire delay between the date the claim was due under MPEP Appendix R §1.55(a)(1) and the date of this Petition was unintentional." As the rule at 37 CFR 1.55(a)(1) pertains to a claim for benefit of priority to a foreign application, this statement is incorrect. The statement should read: "The entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional."

A renewed petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6), along with either a signed Supplemental Application Data Sheet or an amendment complying with the provisions of 37 CFR 1.121, must be submitted to correct the above matters.


Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.

  
Frances Hicks  
Petitions Examiner  
Office of Petitions